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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,491

04/03/2006

Yukio Yoshida

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7590

10/07/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
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EXAMINER

VASISTH, VISHAL V

ART UNIT

PAPER NUMBER

1797

NOTIFICATION DATE

DELIVERY MODE

10/07/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,491	<b>Applicant(s)</b> YOSHIDA ET AL.	
	<b>Examiner</b> VISHAL VASISTH	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4 and 9-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida et al., WIPO Publication No. WO/03/014268 (hereinafter referred to as Yoshida), but for purposes of citations examiner uses column and line numbers from Yoshida et al., US Patent No. 7,402,715 which is the national stage equivalent of the PCT application referred to above.

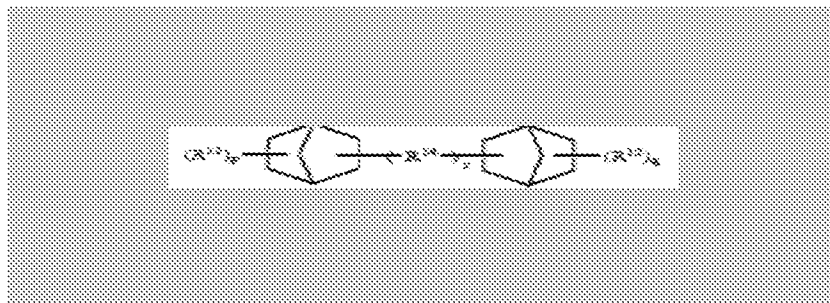
Yoshida discloses a traction drive fluid composition comprising a mixture of hydrocarbon base oils including at least one selected from quaternary carbon atoms and ring structures having the following formula:



wherein R<sup>2</sup> represents an alkyl group having 6 to 13 carbon atoms which may have at least one of alkyl branches and cyclopentane ring, i and j each represent an integer of 0

to 3, and  $i + j$  represents an integer of 1 to 4 (reads on formula (I) of claim 1 and formula (a) of claims 3, 9 and 15 and formula (b) of claims 4 and 16) (Col. 8/L. 30-53).

Yoshida further discloses that the base oil described can be combined with another hydrocarbon base oil having two bridged rings represented by the formula:



wherein R<sup>12</sup> and R<sup>13</sup> each independently represent an alkyl group having 1 to 3 carbon atoms, R<sup>14</sup> represents a methylene group, p and q represent an integer of 0 to 3 and represents 0 or 1 (reads on hydrocarbon compound which has an alicyclic structure as recited in claim 9 and formula (h) of claim 10 and the compounds recited in claims 11-12) (Col. 2-3/L. 60-6).

Yoshida discloses that a mixture of the base oils described above has a viscosity at -40°C of 33,000 mPa·s and a viscosity index of 80 (reads on a viscosity at -40°C of 40 Pa·s or lower and a viscosity index of 80 or higher as recited in claims 1 and 9 and a viscosity at -40°C of 35 Pa·s or lower as recited in claim 2) (Col. 25/Table 2-2).

The fully formulated composition of Yoshida may further comprise additives such as antioxidants, rust preventives, detergent-dispersants, pour point depressants, viscosity index improvers, extreme pressure agents, antiwear agents, oiliness agents, defoaming agents and corrosion inhibitors (additives as recited in claims 13-14) (Col. 11/L. 59-64).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

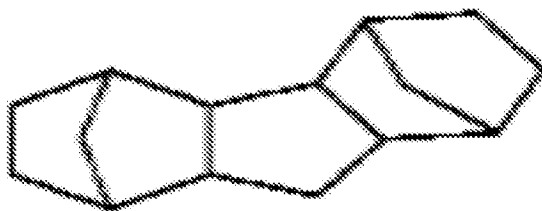
4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claim 5-8 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Matsuno et al., US Patent No. 6,320,088 (hereinafter referred to as Matsuno).

Yoshida discloses all of the limitations discussed above including quaternary carbon atoms and ring structure hydrocarbon base oils. Yoshida does not, however, explicitly disclose these hydrocarbon base oils having cyclic substituents from the non-bridged cyclic structure as exemplified by formulas (c)-(f) of claims 5-8 and 17-20.

Matsuno discloses traction drive fluid compositions comprising a hydrocarbon base oil of a polycyclic structure wherein two bridged groups are fused by the presence of a cyclopentane ring in between them represented by the formula:



this structure reads on formulas (c)-(f) of claims 5-8 and 17-20 when the  $R^2$  groups of those formulas are cycloalkyl groups having 5 to 12 carbon atoms. It would have been obvious to one of ordinary skill in the art to use the hydrocarbon base oils disclosed in Matsuno in the composition of Yoshida in order to enhance the pour point properties of the composition (Col. 2/L. 50-61 of Matsuno).

### ***Conclusion***

6. There were X and Y references disclosed in the PCT search report that was part of the file wrapper to this application that were unused.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VISHAL VASISTH whose telephone number is (571)270-3716. The examiner can normally be reached on M-R 8:30a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1797

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VVV

/Glenn A Caldarola/  
Acting SPE of Art Unit 1797